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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,927	04/05/2004	Marko Kokko	60282.00154	3118
32294 7590 02/17/2010 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212			EXAMINER KING, SIMON	
			ART UNIT 2614	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/816,927

## Applicant(s)

KOKKO ET AL.

## Examiner

SIMON KING

## Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-29, 31-47 and 64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-29, 31-46 and 64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 47 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1-9, 12-29, 31-46 and 64) in the reply filed on 11/25/2009 is acknowledged. The traversal is on the ground(s) that the inventions, as claimed, are not separately usable, and overlap in scope. Examiner respectfully disagree, for Group I, claims 1-9, 12-29, 31-46 and 64, drawn to method, apparatus and computer readable-medium for response server in receiving response content and application specification content and playing the call response to another terminal upon a call or session request. For Group II, claim 47, drawn to apparatus with a transceiver and a processor to program an automatic call response server with an application to create media message including response content and to store one of status of the automatic call response service and history of the automatic call response service. Group II has separate function such as to store one of status of the automatic call response service and history of the automatic call response service. This particular separate utility function is not in any of the claimed subject matters within Group I, therefore, at least one subcombination is separately usable. The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 22, 38 and 64 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As for claim 1, In 6, the cited limitation of "...playing and/or

Art Unit: 2614

transmitting the call response to the another terminal, when....." Examiner is not sure the cited limitation of "and/or" is intended to be "and" or "or" or "and or or". This render claim 1 indefinite since the claimed limitation is not clearly defined. For the purpose of continue examination, examiner shall interpret the cited term "and/or" as "or". Claims 22, 38 and 64 are also rejected for similar reason. Appropriate corrective action is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-8, 12-29, 31-46 and 64 rejected under 35 U.S.C. 102(e) as being anticipated by Marsot (US 2005/0074099 A1).

As for claim 1, Marsot discloses a method (title), comprising: receiving in a response server (Fig.3: message server 114: [0045]) a media message from a terminal (Fig.3: telephone 101: [0042-0045]), the media message comprising response content ([0042]: greeting message) and application specific content ([0043]: XML: Fig.2 and [0039-0044]); using the application specific content to program a call response of the response server ([0042-0043]); and playing and/or transmitting the call response to another terminal (Fig.1: telephone 126), when a call or a session request of the another terminal directed to a user of the terminal is received by the response server (Fig.3 and [0053-0061]).

As for claim 2, 23 and 39, Marsot discloses the method and apparatus, further

comprising: receiving, by the response server, one of the call and the session request from the another terminal directed to the user of the terminal; and playing one of the response content and a part of the response content as a voice mail announcement to the another terminal (see rejection for claim 1).

As for claim 3, Marsot discloses the method, wherein the media message is a multimedia messaging service message (Fig.3: 302-304).

As for claim 5, 24 and 40, Marsot discloses the method and apparatus, further comprising: receiving by the response server one of a call and a session request from the another terminal directed to the user of the terminal; and transmitting one of the response content and a part of the response content to the another terminal in a response media message (see rejection for claim1).

As for claim 6, 25 and 41, Marsot discloses the method and apparatus, further comprising: receiving by the response server one of a call and a session request from the another terminal directed to the user of the terminal; checking a media capability of the another terminal ([0054]; and transmitting one of the response content and a part of the response content to the another terminal in a response media message when detecting that the another terminal has media capability (see rejection for claim 1).

As for claim 7, Marsot discloses the method, wherein one of the response content and the part of the response content is additionally played to the another terminal as a voice mail announcement ([0038]: message played by voice mail server).

As for claim 8, Marsot discloses the method, wherein the transmitted response content includes at least one of audio content, a picture and a video clip (see rejection for claim1).

As for claim 12 and 32, Marsot discloses the method and apparatus, wherein the application specific content includes information for authentication of a sender of the media

message ([0039-0040]: field 202).

As for claim 13 and 34, Marsot discloses the method and apparatus, further comprising: checking the information before authorizing programming of the call response ([0040]).

As for claim 14 and 33, Marsot discloses the method and apparatus wherein the information comprises at least a personal identification number code for authentication and authorization (Fig.2 and [0040]: UID 202).

As for claim 15 and 35, Marsot discloses the method and apparatus, wherein the application specific content includes at least one parameter of: a time of a call; control information for network provided information / assisted operation; different messages based on callee's location; and a validity time of the instructions, wherein the parameters allow different responses to be one of played to different callers and played at different calling times ([0043] and [0058]).

As for claim 16, Marsot discloses the method, further comprising: providing several different media messages, with different audio contents, in the terminal; selecting at least one of the provided media messages; and transmitting and processing the at least one selected media messages ([0012]).

As for claim 17 and 44, Marsot discloses the method and apparatus, wherein the media message comprises caller identification information, and the method further comprises: associating the response content with the user of the terminal and with caller identification information ([0040-0041]).

As for claim 18 and 45, Marsot discloses the method and apparatus, further comprising: receiving at least two response contents associated with the user of the terminal and to different caller identification information in the server ([0040-0041]).

As for claim 19, 29 and 46, Marsot discloses the method and apparatus, comprising:

receiving by the response server one of a call and a session request of the another terminal directed to the user of the terminal, detecting a caller identification information of the caller, and one of playing the response content to the another terminal, and responds with a media message comprising the response content, wherein the response content is associated with the user of the terminal and with detected caller identification information corresponding to the caller ([0056-0058]).

As for claim 20 and 36, Marsot discloses the method and apparatus, wherein providing the media message in the terminal comprises providing the media message in a mobile terminal (see rejection for claim 1).

As for claim 21, 37 and 43, Marsot discloses the method and apparatus, wherein the response server is implemented in a multimedia messaging service center (Fig.1: message server 114 able to process multimedia messaging).

As for claim 22, Marsot discloses an apparatus (Fig.1), comprising: a receiver configured to receive from a terminal a media message which includes response content and application specific content; and a processor configured to store the response content, and to use the application specific content to program a call response of the apparatus, wherein the apparatus is configured to play and/or transmit the call response to another terminal, when a call or a session request of the another terminal directed to a user of the terminal is received by the apparatus ([0034-0036])(also see rejection for claim 1).

As for claim 26, Marsot discloses the apparatus, wherein: several different media messages ([0014]: greeting messages), including multimedia messaging service messages with different response contents ([0012]: voice mail messages with MMS), are provided in the terminal, at least one of the provided media messages are selected by the terminal, and the at least one of the selected media message are transmitted and processed in the apparatus

Art Unit: 2614

([0058]).

As for claim 27, Marsot discloses the apparatus, wherein the media message includes caller identification information indicating a caller of one of a call and a session received by the apparatus, and wherein the receiver is configured to receive the response content of the media message in the apparatus associated with the terminal and with the caller identification information (Fig.2 and [0040]: UID 202).

As for claim 28, Marsot discloses the apparatus, wherein the receiver is configured to receive at least two response contents associated with the terminal or the user of the terminal, and with different caller identification information ([0040-0041]).

As for claim 31, Marsot discloses the apparatus, wherein the apparatus comprises a processor configured to remove the application specific content (Fig.1: microprocessor 116).

As for claim 38, Marsot discloses an apparatus, comprising: a receiver configured to receive, from a terminal, a media message which includes response content and application specific content; and a processor configured to process the media message to derive the response content, to store the derived response content of the media message, to process the application specific content, to program a call response of the apparatus, and to play and/or transmit the call response to another terminal, when a call or a session request of the another terminal is directed to a user of the terminal is received by the apparatus (see rejection for claim 22).

As for claim 42, Marsot discloses the apparatus, wherein the media message sent to the apparatus includes application specific content, and wherein the processor is configured to process the application specific content, and to remove the application specific content (see rejection for claim 1).

As for claim 64, Marsot discloses a computer-readable storage medium encoded with



instructions configured to control a computer to perform a process, the process comprising: receiving, from a terminal in a response server a media message, the media message comprising response content and application specific content; using the application specific content to program a call response of the response server; and playing and/or transmitting the call response to another terminal, when a call or a session request of the another terminal directed to a user of the terminal is received by the response server (see rejection for claims 1 and 22).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Marsot (US 2005/0074099 A1) in view of Mohan et al. (US 2003/0063590 A1).

As for claim 4, Marsot discloses the method for the media message except where the media message is a session initiation protocol message.

However, Mohan discloses where session initiation protocol message for the purpose of providing signal protocol for Internet conferencing and telephony presence (Mohan: [0074]).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement session initiation protocol message as taught by Mohan in Marsot for the purpose of providing signal protocol for Internet conferencing and telephony presence.

As for claim 9, Marsot in view of Mohan discloses the method, wherein the transmitting one of the response content and the part of the response content in the response media message comprises transmitting one of a multimedia messaging service message and a session initiation protocol message (see rejection for claim 1 and 4).

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-9, 12-29, 31-46 and 64 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIMON KING whose telephone number is (571)270-1950. The examiner can normally be reached on 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, FAN TSANG can be reached on (571)272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10 February 2010

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Examiner, Art Unit 2614

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